

REMARKS

Applicant responds to the issues raised in the February 17, 1994 Office Action in the order in which they appear in that correspondence.

THE SECTION 112, FIRST PARAGRAPH REJECTION
MUST BE WITHDRAWN

Applicant has amended claim 67 to claim video products stored on CD-ROM as part of the information storage means. This language is clearly supported by the specification. See the Technical Field section of the originally filed specification.

The Examiner has rejected claims 14-24, 26-29, 33-34, 38-39, 66-76, 78-81, 85-86, 90-91 under 35 U.S.C. § 112, first paragraph. The Examiner contends that the original specification does not adequately support the language "maintaining control" of the playback "throughout the duration of the selection playback." Applicant respectfully traverses.

The language "maintaining control" of the playback "throughout the duration of the selection playback" is intended to convey that the claimed system is interactive and under user control. The user can choose one of the selections from the identified product. The selections are presented on a display. (During the playback of one of the selections, the user can go on to other selections from the same product, or the user can go on to preview other products.) The language "maintain control" is meant to indicate that feature of the system which enables the user not to have to sit through all selections from that product played in a specific order or for a specific length of time. Rather, the user can interact with the claimed system and choose which selection he/she wants to hear and decide how long he/she wants to listen to that selection. (All of this is in contrast to the prior art, such as the Stern et al.) system discussed below in which, once the product is identified to the system, the user must listen to that preview and since there are no other selections affiliated with the identified product, there is only one preview to be displayed.

With this as background, applicant submits that the language "maintain control" is adequately supported by the specification as originally filed. The most apparent support is found in Figure 3 which illustrates the user screen which is presented during a preview session. This screen presents the user with five different musical selections from the album *Born in the USA*. The user can choose one of these selections for preview. While one selection is being played back, the user may decide to select another and is free to do so by touching the screen. Throughout the specification there is additional support. Referring to the specification of the related issued patent, U.S. Patent No. 5,237,157, the bottom of column 2 makes the point that the purpose of the kiosk station is to provide access to music products through sampling of individual selections as discrete increments of information. In connection with the description of the graphical interface found at column 3, it is explained that the user chooses among selections for preview by touching the name of the desired song on the touch screen. (Col. 3, ll. 15-26.) See also, col. 5, ll. 61-end; col. 6, ll. 1-3. In sum, the specification describes a system in which the user has control over the choice and playback of the selections during the time that the product is being previewed. Even though the phrase "maintain control" was not specifically used in the original specification, the conceptual basis for the language is inherent in the specification which therefore provides adequate support for the claims. On this basis, applicant respectfully requests that this basis for rejection be removed.

If the Examiner deems it necessary to provide explicit support for this inherent disclosure, applicant respectfully requests the opportunity to amend the specification in accordance with the Examiner's instructions.

THE OBVIOUSNESS REJECTION BASED UPON
STERN ET AL. MUST BE WITHDRAWN

The Examiner has rejected claims 14-17, 22-23, 26, 33, 38, 66-69, 74-75, 78, 85 and 90-91 under 35 U.S.C. § 103 as unpatentable over Stern et al. Applicant respectfully traverses this rejection.

In contrast to the system described in Stern et al., the present invention provides for the identification of a product for previewing, followed by user choice of selections

from the product for previewing. It is a two-step process, involving at least a second degree of user interaction with the system. Stern et al. do not teach a two step process. Rather, in the Stern et al. device, a keypad is presented to the user with album covers. The user identifies an album for preview and the Stern et al. device does the rest, i.e., it displays the preview segment (video clip) associated with the album identified by the user. There is no subsequent interaction by the user. The device plays the single segment affiliated with the user's album identification. The Stern et al. device does not provide the user with any other choices to be made concerning the identified album.

A. The Controlled Playback Feature

The Examiner has argued that the "maintain control over playback" feature of the claimed invention would have been obvious in view of Stern et al. because Stern et al. provide an optical disk player which is presumably equipped with controls for pausing, stopping or skipping playback. The Examiner's rejection implies that Stern et al. could be modified to provide user access to these controls. However, the Examiner's rejection fails to account for what Stern et al. teach as a whole, as contrasted with the claimed invention. There is no provision made in the Stern et al. device to allow direct user interaction with the playback of video clips, and especially for user choice among multiple selections for a single product. The user interface in the Stern et al. device also does not permit user access to any controls for pausing, stopping or skipping playback. It would not be apparent, nor suggested by the disclosure of Stern et al., how to modify their system to provide a user interaction level such as that claimed here, including both multiple selections and user control of playback. The Stern et al. device has a very simple interface and the ability for the user to maintain control over selection playback is not suggested or motivated by the Stern et al. disclosure, particularly since Stern et al. teach preview of a single clip from the product. Applicant respectfully submits that this basis for rejection must fail because there is no suggestion or motivation in Stern et al. to modify the user interface in Stern et al. to obtain the level of selection and control claimed here. This aspect of the rejection must be withdrawn.

B. The Proposed Modification to Enable Choosing Among Selections

In the second major basis for the obviousness rejection based on Stern et al, the *Examiner has admitted* that the Stern et al. device does *not* teach means for identifying a product *and* means for choosing among selections from a product.¹ Rather, the Examiner contends that Stern et al. provide the motivation to modify the architecture of their device to obtain a system like the one claimed here. It is clear that the present invention has a greater degree of user interactivity than the Stern et al. device because it permits the selection and controlled playback of the selections associated with the product. The present invention enables the customer to preview more of the identified product than does the Stern et al. device. While the object of the Stern et al. device is to enable the customer to preview something about a product, the Stern et al. device is not configured to enable the higher level of user interaction which is permitted by the claimed invention. The Stern et al. device provides a product identification technique which would not accommodate an additional level of user choice among various selections. The Stern et al. user interface simply does not provide for second level interaction (choice among selections), nor is it apparent from the teaching of Stern et al. how their interface would be modified to provide the enhanced level of interactivity claimed here.

In its preferred embodiment, the Stern et al. system provides a keypad on which the albums available for preview are identified. The keypad enables the input of one dimension of data: product identification. It does not provide the user with an interface into which further commands about the identified product may be entered. Contrary to the premise of the Examiner's basis for rejection, it would not be trivial to modify the Stern et al. system to obtain the claimed system. The Examiner's proposed modification, which is admittedly not explicitly described, would entail a great deal of system modification to accommodate this additional second level of interaction. The keypad interface is not provided with enough depth to enable the addition of this level of user

¹ The Examiner contends that "the album cover buttons of Stern et al simultaneously identify the product and the selection to be previewed. (Office Action at 5.) Applicant respectfully disagrees that this disclosure can be found in Stern et al.

choice. Therefore, it is not a trivial matter to go from the keypad interface of Stern et al. to the multidimensional user interface of the claimed system which provides for two levels of user input: product identification and choice of selections on the product.

C. Applicant's Rule 132 Declaration
Overcomes Any Prima Facie Obviousness

Applicant submits herewith the Declaration of Gary Schwede. Mr. Schwede has actual experience in the design and implementation of user interfaces in the area of audio previewing. His declaration sets forth several reasons why the modifications to Stern et al. proposed by the Examiner would not have been obvious at the time that the present invention was made in 1990. Moreover, the declaration sets forth significant differences between the systems which would teach away from modifying Stern et al. to achieve the claimed invention.

THE OBVIOUSNESS REJECTION BASED UPON STERN ET AL.
COMBINED WITH HUGHES ET AL. MUST BE WITHDRAWN

The Examiner has rejected claims 18-21, 27-29, 70-73 and 79-81 under 35 U.S.C. § 103 as being unpatentable over Stern et al. as applied above, and further in view of Hughes et al. Applicant respectfully traverses this rejection.

Applicant incorporates his arguments on the issue of the obviousness of the claimed invention in view of Stern et al. Moreover, applicant incorporates the statements made in the Rule 132 Declaration of Gary Schwede.

Applicant further traverses this rejection because the proposed combination of references is improper. Stern et al. provides a system for previewing of video clips associated with audio products. Hughes et al. provide a system for the coin-operated production of audio cassettes. The only real similarity between these references is at a very high level: they both pertain to music audio products. However, that is essentially where any similarity ends.

The Stern et al. preview device does not provide for monetary input, nor production of cassette tapes. It has a simple display and associated audio/video output.

On the other hand, the Hughes et al. device has an inventory of copyrighted works available for the individualized production of audio cassettes. It requires money to operate and is not designed for previewing products. It is designed for production of products. Therefore, it is not understood why someone in the art would combine the features of these two very different systems, with different purposes and structures to obtain some of the features of the claimed invention. Applicant respectfully submits that these two references are so different that there would be no motivation to combine them. Therefore, applicant submits that this combination cannot properly form the basis of an obviousness rejection of these claims and respectfully requests that this rejection be withdrawn.

Even assuming that the combination of Stern et al. and Hughes et al. is proper, applicant respectfully submits that the combined teachings of these references fails to render the claimed invention unpatentable as obvious. The Examiner has admitted that Hughes et al. fails to teach the collection of data for market research purposes. Hughes et al. teach the collection of selection frequency for calculating royalty obligations. There is no suggestion that this same information can be separately packaged and sold as market research. Nor is there any suggestion in Stern et al. that it would be beneficial to do so. There is absolutely nothing in either of the references which teaches or suggests using this frequency information for market research. This is clearly a case of hindsight reconstruction once the Examiner had the benefit of the claimed invention. The combined teachings of the cited references does not render the claimed invention unpatentable as obvious under 35 U.S.C. § 103. The rejection must be withdrawn and the claims passed to issue without amendment.

CONCLUSION

Applicant submits that all of the Examiner's rejections have been overcome. This application should be promptly passed to issue.

Respectfully Submitted,
DERGOSITS & NOAH

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